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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARION SCOTT BRIGHT,
PUSHPALATHA CHANNIKERE,
BALASUBRAMANIAN GOPALAN,
RAHUL JINDANI,
JINRAJ DHRUVAKUMAR JOSHIPURA,
VINOD KANNOTH,
JAYAKUMAR KRISHNAMURTHY,
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SYLVAIN MICHEL,
PENNY JEANETTE PEACHEY-KOUNTZ, and
JAMES DONALD SCOTT

Appeal 2008-2915
Application 09/303,368
Technology Center 3600

Decided:¹ April 28, 2009

¹The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Before HUBERT C. LORIN, ANTON W. FETTING, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

An oral hearing was held on Jan. 15, 2009.

STATEMENT OF THE CASE

Marion Scott Bright, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1, 3, 4, 6, 8, 9, 11, 13-15, and 25-31. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.²

THE INVENTION

“The present invention generally relates to pre-processing electronic commerce requests and, more particularly, to a method and system for modifying electronic commerce requests before they are sent to an order processing system.” Specification 1:7-10.

Sole independent claims 1 and 31, reproduced below, are illustrative of the subject matter on appeal.

1. A system for pre-processing orders before

² Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Jul. 19, 2006) and Reply Brief (“Reply Br.,” filed Nov. 13, 2007), and the Examiner’s Answer (“Answer,” mailed Sep. 17, 2007).

they are transmitted to an order processing system, comprising:

- an order interceptor receiving and pre-processing electronic sales order data prior to transmitting to the order processing system, the order interceptor being capable of adding, changing, and deleting electronic sales order data, wherein changes to an electronic sales order are logged so as to provide an audit trail of activity;

- an interface system receiving the electronic sales order data from the order interceptor and performing an availability check, wherein the availability check determines the portions of the electronic sales order data that can be satisfied; and

- means for transmitting at least a portion of the electronic sales order data to the order processing system for order processing.

31. A system for pre-processing orders before they are transmitted to an order processing system, comprising:

- an order interceptor receiving and pre-processing electronic sales order data prior to transmitting to the order processing system, wherein pre-processing the electronic sales order includes splitting the electronic sales order into at least two separate requests prior to transmitting to the order processing system;

- an interface system receiving the electronic sales order data from the order interceptor and performing an availability check, wherein the availability check determines the portions of the electronic sales order data that can be satisfied; and

- means for transmitting at least a portion of the electronic sales order data to the order processing system for order processing.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Johnson

US 6,023,683

Feb. 8, 2000

The following rejection is before us for review:

1. Claims 1, 3, 4, 6, 8, 9, 11, 13-15, and 25-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson.

ARGUMENTS

This application (09/303,368) was previously before the Board on appeal (2003-0901; decided Aug. 6, 2004), where the Board affirmed the rejection of claims 1, 3, 4, 6, 8, 9, 11, and 13-24 under § 103 over Johnson. The claims before this panel are not those that were before the Board in appeal 2003-0901. Claim 1, for example, has since been amended. Claim 1 previously on appeal read as follows:

1. A system for pre-processing orders before they are transmitted to an order processing system, comprising:
an order interceptor receiving and pre-processing electronic sales order data prior to transmitting to the order processing system;
an interface system receiving the electronic sales order data from the order interceptor and performing an availability check, wherein the availability check determines the portions of the electronic sales order data that can be satisfied; and
means for transmitting at least a portion of the electronic sales order data to the order processing system for order processing.

Since that decision, claim 1 has been amended to further define the “order interceptor” as “being capable of adding, changing, and deleting electronic sales order data, wherein changes to an electronic sales order are logged so

as to provide an audit trail of activity” (claim 1). Claim 3, 4, 6, 8, 9, 11, 13-15 do not appear to have been further amended. Claims 25-31 were added after the prior Board decision and thus have not been previously before the Board.

Claim 1

The Appellants challenge the Examiner’s rejection of claim 1. (App. Br. 7-10.) In particular, the Appellants have argued that Johnson does not disclose the limitation “order interceptor being capable of adding, changing, and deleting electronic sales order data, wherein changes to an electronic sales order are logged so as to provide an audit trail of activity” in the claim.

As to this limitation, the Examiner responded as follows:

Regarding the argument that no proper interpretation of Johnson discloses or suggests an order interceptor that is capable of adding, changing, or deleting electronic sales order data, wherein changes to an electronic sales order are logged, Johnson et al. indeed disclose or suggest an order interceptor that is capable of adding, changing, or deleting electronic sales order data, wherein changes to an electronic sales order are logged. See, in particular, column 15, lines 60-62 [].

Answer 6.

The Appellants responded, disagreeing that the disclosure at column 15, lines 60-62 of Johnson to which the Examiner referred discloses an “order interceptor” “being capable of adding, changing, and deleting electronic sales order data, wherein changes to an electronic sales order are logged so as to provide an audit trail of activity” (claim 1).

Such language [referring to column 15, lines 60-62 of Johnson, see supra] says nothing about an order

interceptor being capable of adding, changing, and deleting electronic sales order data, much less, that changes to an electronic sales order are logged so as to provide an audit trail of activity. Nor has the Examiner explained how such language is suggestive of this feature.

Reply Br. 3.

Claim 31

The Appellants challenge the Examiner's rejection of claim 31. App. Br. 11-13.

Claim 31 describes a system comprising three elements: (1) an order interceptor; (2) an interface system; and, (3) means for transmitting at least a portion of the electronic sales order data to the order processing system for order processing. Claim 31 differs from claim 1 in that, though it also describes a system comprising an order interceptor, the order interceptor is not required to be "capable of adding, changing, and deleting electronic sales order data, wherein changes to an electronic sales order are logged so as to provide an audit trail of activity" (claim 1). Rather, it is required to be capable of receiving and pre-processing electronic sales order data prior to transmitting to an order processing system, wherein pre-processing the electronic sales order includes splitting the electronic sales order into at least two separate requests prior to transmitting to the order processing system.

The Examiner's concedes that "Johnson et al. do not specifically teach splitting the electronic sales order into at least two separate requests prior to transmitting to the order processing system." Answer 4. However, according to the Examiner, "splitting an electronic order into two separate requests is certainly well known, hence obvious, step to follow on processing an electronic order." Answer 4.

The Appellants argued that just because a feature may be well known does not make a combination involving the well-known feature per se obvious. App. Br. 11. Nevertheless, the Appellants have urged the Examiner to provide evidentiary support for the Examiner's assertion that the subject matter that is claimed was well known in the art or of common knowledge in the art capable of instant and unquestionable demonstration as being well-known. Answer 12. The Appellants further argued that Johnson shows a computer that maintains a catalog database and a means for generating a requisition whereby a user may manually enter information about an item desired to be requisitioned so as to search the database for matching catalog items and generating a requisition thereof, and that such a system does not suggest the features for the system set forth in claim 31. App. Br. 12.

The Examiner responded by arguing that

such functionality [i.e., splitting the order into separate requests/orders prior to transmitting the order to the order processing system] is indeed well known, and, in any event, the system of Johnson et al. performs such functionality, splitting the order into two separate requests/orders prior to transmitting the order to the order processing system. See, in particular, column 15, lines 52-54, and column 17, lines 44-47.

Answer 6.

The Appellants replied, in part, that the Examiner has failed to show that Johnson discloses the order interceptor as claimed, which receives and pre-processes the electronic sales order data and splits the electronic sales order into at least two separate requests. Reply Br. 4.

ISSUES

The issues are:

- Have the Appellants shown that the Examiner erred in rejecting independent claim 1, and claims 3, 4, 6, 8, 9, 11, 13-15, and 25-30 dependent thereon, under 35 U.S.C. § 103(a) as being unpatentable over Johnson on the grounds that the scope and content of Johnson is such that it does not disclose the order interceptor as claimed and as the Examiner has argued?
- Have the Appellants shown that the Examiner erred in rejecting independent claim 31 under 35 U.S.C. § 103(a) as being unpatentable over Johnson on the grounds that Johnson, alone or in view of the alleged well known functionality of splitting an order into separate requests/orders prior to transmitting the order to an order processing system, would not lead one of ordinary skill in the art to the claimed system?

PRINCIPLES OF LAW

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and

(3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

Claim 1

Claim 1 defines a “system for pre-processing orders before they are transmitted to an order processing system, comprising: an order interceptor receiving and pre-processing electronic sales order data prior to transmitting to the order processing system, the order interceptor being capable of adding, changing, and deleting electronic sales order data, wherein changes to an electronic sales order are logged so as to provide an audit trail of activity” Accordingly, claim 1 defines a system comprising (1) an order interceptor and (2) an order processing system.

We turn now to Johnson.

Johnson describes a method to provide a user of an electronic sourcing system the capability of searching a database for items available from at least two vendor product catalogs and transferring information for desired catalog items for use in a requisition. See col. 2, ll. 46-56. Johnson shows an electronic sourcing system in Fig. 1A (element 5) and it includes a requisition/purchasing system 40 comprising program modules such as an Inventory Sourcing program or programs 44B. See discussion at col. 4, ll. 1-

19. In operation, a user creates a requisition in system 40 by first entering information on a screen. Col. 6, ll. 54-65. Pressing a particular function key causes the system to jump to the Inventory Sourcing program or programs 44B. Col. 7, ll. 11-13. Via a search program, vendor catalogs in a catalog database are searched and items are selected and added to an Order List. Col. 11, l. 30-31. Once the Order List is complete, a user can transmit it to the requisition/purchasing system 40 (col. 12, ll. 48-50) where it is transferred to a requisition program (col. 13, ll. 1-5). Once items are identified for requisitioning, “[t]he next step is that of inventory sourcing using RIMS inventory sourcing program or programs 44B in Fisher RIMS system 40, as shown in Fig. 3. Inventory sourcing is the process of determining what inventory will be used to fill the requisition.” Col. 14, ll. 4-8.

With this understanding of what Johnson discloses, we now return to the Examiner’s position that the disclosure at column 15, lines 60-62 of Johnson discloses or suggests an “order interceptor” “being capable of adding, changing, and deleting electronic sales order data, wherein changes to an electronic sales order are logged so as to provide an audit trail of activity” (claim 1).

Column 15, lines 60-62 of Johnson reads as follows: “Electronic sourcing system 5 also contains the capability to log messages returned from inventory sourcing program or programs 44B of Fisher RIMS system 40.”

There is no disclosure of an “order interceptor,” as claimed, in the passage at column 15, lines 60-62. Nowhere in this passage is there any discussion of an element for adding, changing, or deleting electronic sales order data. Because the capability to log messages is described as included

as part of the “electronic sourcing system 5,” we presume the Examiner is taking the position that Johnson’s “electronic sourcing system 5” necessarily meets the limitation “order interceptor being capable of adding, changing, and deleting electronic sales order data” of claim 1.³ We disagree. One of ordinary skill in the art reading this passage would understand Johnson to be describing an electronic sourcing system having a capability of logging messages from a requisitioning/purchasing system. But there is nothing in that passage, read alone or in the context of Johnson as a whole (see earlier discussion of Johnson), that would give one of ordinary skill in the art a reason to provide Johnson’s electronic sourcing system with the additional function to add, change, or delete electronic sales order data.

Because the scope and content of Johnson is such that it does not disclose the order interceptor as claimed, as the Examiner has argued, we find that a prima facie case of obviousness has not been made out. Accordingly, we find that the Appellants have shown that the Examiner erred in rejecting independent claim 1, and claims 3, 4, 6, 8, 9, 11, 13-15, and 25-30 dependent thereon, under 35 U.S.C. § 103(a) as being unpatentable over Johnson.

³ It is necessary to explain our understanding of the logic underlying the Examiner’s position because the Answer fails to do so. Initially the Examiner states that “Johnson et al. clearly anticipates all of the substantive elements of the instant invention ... ” (Answer 3) but does not explain, via e.g., an element-by-element comparison, how Johnson describes the claimed subject matter. In the response to the arguments (Answer 6), the Examiner relied on column 15, lines 60-62 of Johnson to show Johnson disclosed the order interceptor as claimed. But there, too, the Answer does not provide an apparent reason with logical underpinning explaining how exactly Johnson would lead one of ordinary skill in the art to the order interceptor as claimed.

Claim 31

We also do not find that the Examiner has made out a prima facie case of obviousness for the claimed subject matter of claim 31.

Claim 31 is directed to a system. The Examiner's contention that "splitting an electronic order into two separate requests is certainly a well known, hence obvious, step to follow on processing an electronic order" (Answer 4) assumes claim 31 requires such a splitting step. However, claim 31 is not drawn a method. Rather, claim 31 is directed to an apparatus comprising the element "order interceptor." Furthermore, according to the claim, the "order interceptor" is required to be capable of receiving and pre-processing electronic sales order data prior to transmitting to an order processing system, wherein pre-processing the electronic sales order includes splitting the electronic sales order into at least two separate requests prior to transmitting to the order processing system. Accordingly, the Examiner's assertion that a splitting step per se was well known fails to appreciate fully what the claim is calling for.

Moreover, the Examiner does not explain what precisely is relied upon in Johnson for disclosure of an order interceptor which would be modified in light of the alleged well known aspect of splitting an electronic order to arrive at the claimed invention. We presume the Examiner means to take the same position with respect to the "order interceptor" of claim 31 as was taken with respect to claim 1 where the Examiner relied on the disclosure at column 15, lines 60-62 as disclosing or suggesting an "order interceptor." But, as we have already discussed, the passage at column 15, lines 60-62 of Johnson makes no mention of an "order interceptor," let alone one having the function described in claim 31. Accordingly, we do not find

that a prima facie case of obviousness has been established for the claimed subject matter over Johnson in view of the alleged well known step of splitting electronic orders.

As an alternative to asserting that splitting electronic orders is well known, the Examiner also cites to col. 15, ll. 52-54 [sic., ll. 50-54], and col. 17, ll. 44-47 of Johnson as evidence that Johnson discloses such a splitting of orders. Answer 6.

The two Johnson passages the Examiner cites to state “[i]t is an important feature of the present invention that a requisition may be filled by searching and selecting from a catalog database of items, inventory sourced, and the resulting requisition then divided into one or more purchase orders” and “[t]he CSR, knowing which items are available from which Distributor warehouse and direct-shipping supplier, then may divide the customer’s requested items into multiple orders, so as to assure that each order is completely filled by a single shipment,” respectively. These passages provide a general indication that orders may be divided. We do not see that the Examiner has explained how one of ordinary skill in the art would be led to the system claimed given this general indication that orders may be divided, especially given, as we have discussed, Johnson’s lack of any mention of an “order interceptor.” While Johnson discloses splitting an order, claim 31 is drawn to a system that does not simply splits orders. The system that is claimed requires there be an “order interceptor” for receiving and pre-processing electronic sales order data prior to transmitting to an order processing system, wherein pre-processing the electronic sales order includes splitting the electronic sales order into at least two separate requests prior to transmitting to the order processing system. Because that is not

disclosed and the Examiner has not provided an apparent reason with logical underpinning that would lead one of ordinary skill in the art to a system having an “order interceptor” as claimed, i.e., one that is capable of receiving and pre-processing electronic sales order data prior to transmitting to an order processing system, wherein pre-processing the electronic sales order includes splitting the electronic sales order into at least two separate requests prior to transmitting to the order processing system, we find that a prima facie case of obviousness of the claimed subject matter over Johnson alone has not been established.

Accordingly, we find that the Appellants have shown that the Examiner erred in rejecting independent claim 31 under 35 U.S.C. § 103(a) as being unpatentable over Johnson, alone or in view of the alleged well known functionality of splitting an order into separate requests/orders prior to transmitting the order to an order processing system.

CONCLUSIONS OF LAW

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 1, 3, 4, 6, 8, 9, 11, 13-15, and 25-31 under § 103(a) as being unpatentable over Johnson.

DECISION

The decision of the Examiner to reject claims 1, 3, 4, 6, 8, 9, 11, 13-15, and 25-31 is reversed.

Appeal 2009-2915
Application 09/303,368

REVERSED

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